

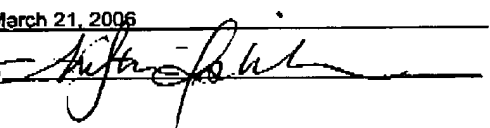

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1601457-0013	
VIA FACSIMILE			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 21, 2006</u> Signature <u></u> Typed or printed name <u>Christina Ishihara</u>		Application Number <u>10/092,178</u>	Filed <u>March 5, 2002</u>
		First Named Inventor <u>Teng Pin Poo et al.</u>	
		Art Unit <u>2182</u>	Examiner <u>Casiano, Angel L.</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u></u> Signature	
<input type="checkbox"/>	applicant/inventor.	<u>Warren S. Heit</u> Typed or printed name	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. <u>36,828</u> Registration number	<u>650.213.0300</u> Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34	<u>March 21, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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US Patents Pages 17/53 - 30/53

ATTACHMENT TO THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Office Action dated September 21, 2005, claims 1-9 and 12-14 stand rejected. Applicants respectfully submit that the Examiner's rejections of claims 1-9 and 12-14 as set forth in the Office Action are improper, and that claims 1-9 and 12-14 are allowable over the cited art for the reasons set forth below.

A. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-9 and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Publication No. 2002-232769 A (hereinafter "*Gotanda*") in view of U.S. Patent Application No. 6,748,541 B1 (hereinafter "*Margalit*"). Having reviewed the Examiner's remarks, Applicants respectfully disagree with the Examiner's reading of the disclosures in *Gotanda* and *Margalit* and submit that *Gotanda* and *Margalit*, alone or in combination, fail to teach or disclose various claimed limitations of the pending claims.

Claim 1 requires, among other things, a portable camera device having an integrated USB plug that facilitates direct coupling of the portable camera device to a USB socket of a host platform via the USB plug. Claim 1 of the present application recites:

1. A portable camera device capable of operation with a host platform, the portable camera device comprising:
 - a housing;
 - a USB plug* integrally adapted to the housing of the portable camera device to facilitate direct coupling of the portable camera device via the USB plug to a USB socket of the host platform;
 - a non-volatile memory in communication with said USB plug;
 - a digital camera, *integrally formed with said non-volatile memory*, for capturing image and/or audio information, *said non-volatile memory capable of storing said image and/or audio information*; and
 - a microprocessor for at least in part formatting said image and/or audio information in a standard image and/or audio file format compatible with the host platform.

(emphasis added).

Claims 12 and 14 likewise requires a portable camera device having an integrated USB plug as presented above. Claim 12 recites in pertinent part:

12. A method of capturing image and/or audio information and uploading the image and/or audio information to a host platform, comprising the steps of:
- (a) capturing image and/or audio data using a portable camera device, *said portable camera device having a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the portable camera device via the USB plug to a USB socket of the host platform;*

* * *

(emphasis added).

Claim 14 recites in pertinent part:

14. A method of authenticating an operator seeking access to information on a storage medium, comprising the steps of:
- (a) capturing image and/or audio identification data via a digital camera, *said digital camera having a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the digital camera via the USB plug to a USB socket of a host platform;*

* * *

(emphasis added).

Gotanda teaches connecting a digital camera 2 to a personal computer via a USB connector 46. It is important to note, however, that element 46 in *Gotanda* is a USB socket, not a USB plug as disclosed and claimed in the present application. A skilled artisan would not use a USB plug and a USB socket interchangeably because they have different usage and application. In particular, having read the disclosure in *Gotanda*, a skilled artisan would not seek to replace the USB socket 46 with a USB plug. Moreover, element 46 in *Gotanda* is located at what appears to be a base or cradle for the camera, and not on the camera itself. As such, *Gotanda* not only fails to disclose Applicants' claimed invention that includes an integrated USB plug, but also teaches away from it by teaching the use of a USB socket.

Further, claim 1 includes the limitation that the digital camera is integrally formed with the non-volatile memory. In contrast, *Gotanda* teaches using a memory card 15 (element 15 is labeled as a memory card in the figure in *Gotanda*) in the camera. A skilled

artisan would readily understand that a memory card refers to a removable memory that can be conveniently inserted into or taken out of the camera by a user. Any compatible memory card can be used with the camera and can be easily swapped in and out as the user wishes. The memory card taught in *Gotanda* cannot be integrally formed with the portable digital camera disclosed therein. Therefore, *Gotanda* not only fails to disclose Applicants' claimed invention that includes an integrally formed non-volatile memory, but also teaches away from it by teaching the use of a removable memory card.

The Examiner agrees that *Gotanda* fails to teach a portable camera having an integrated USB plug to facilitate direct coupling of the camera via the USB plug to a USB socket of a host platform and an integrally formed non-volatile memory, as required by the claims, but cites *Margalit* and contends that it remedies the deficiencies. The Examiner also states that it is obvious to modify *Gotanda* to come up with Applicants' claimed invention, and that *Margalit* provides the motivation to do so. Applicants respectfully disagree.

Applicants submit that there is no motivation for a skilled artisan to combine the teachings in *Gotanda* and *Margalit*. The law is clear that, before prior art references can be combined, the Examiner must show some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Nor is the fact that references can be combined sufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The Examiner needs to show the

additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

Applicants respectfully traverse that *Gotanda* and *Margalit* are combinable. *Gotanda* teaches a digital camera that can be connected to a personal computer. *Margalit* teaches a user authentication or security device. There is no motivation or suggestion in the art to combine the digital camera of *Gotanda* with the user authentication or security device of *Margalit* to arrive at the present invention.

Margalit teaches using a so-called "FCCS plug device ... borne by a mobile user" having "information characterizing the mobile user and stored in the memory accessibly to the flexibility connected computer system." See col. 2, lines 23-30. *Margalit* also teaches that the information stored in the FCCS plug device is used to perform authentication. See col. 2, lines 9-21. In other words, *Margalit* teaches a user authentication or security device. Moreover, in Figures 3 and 4, *Margalit* seems to have defined its own proprietary plug.

A digital camera such as taught by *Gotanda* and a security device such as taught by *Margalit* are two unrelated devices in different technical fields; designing and building such unrelated devices involves distinct endeavors. As such, a skilled artisan would not seek to combine *Gotanda* and *Margalit* to come up with the claimed invention as the Examiner has suggested. A digital camera such as taught by *Gotanda* does not have a USB plug, so it cannot be directly coupled via a USB plug thereon to a USB socket of a host. Rather, the camera is connected to a host by a USB cable. There is no teaching in *Gotanda* of the need to achieve direct connectivity to a host computer. Further, a digital camera such as taught by *Gotanda* is not in a form factor such that it can be directly connected a host computer. There is no teaching in *Gotanda* of the need or ability to miniaturize the camera such that it could be in a form factor that could be directly connected to a computer. In addition, *Margalit* teaches a security device and not a mass storage device. There is no teaching in *Margalit* that

it had the memory capacity to receive and store large amounts of data such as pictures taken by a digital camera. As such, there is no motivation or suggestion in the cited references to combine the digital camera of *Gotanda* with the security device of *Margalit* to arrive at the present invention.

The Examiner points to element 65 in Figure 4 of *Gotanda* for the proposition that *Gotanda* teaches image data is formatted by the *Gotanda* device into a compatible file format for the host platform. Applicants respectfully traverse. The Examiner has not specifically identified any disclosure in *Gotanda* that teaches formatting image and/or audio data in a standard file format compatible with the host platform, which is another claim limitation of claim 1. Without more, element 65 of *Gotanda* in and of itself cannot be considered to teach or disclose this claim limitation. *Margalit* fails to disclose this limitation as well.

B. Conclusion

For at least the foregoing reasons, independent claims 1, 12 and 14 are allowable over *Gotanda* and *Margalit*, whether alone or in combination. If an independent claim is allowable over the cited art, then any dependent claim therefrom is also allowable over the cited art. Claims 2-9 depend on claim 1; and claim 13 depend on claim 12. Consequently, they are all allowable over *Gotanda* and *Margalit*. As such, claims 1-9 and 12-14 are patentable over the cited references, and early notification of allowance of claims 1-9 and 12-14 is earnestly requested.